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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,639	11/01/2000	Bruce L. Finn	D-8139	4501

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EXAMINER


NEGRON, ISMAEL

ART UNIT PAPER NUMBER

2875

DATE MAILED: 06/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/704,639	FINN ET AL.	
	Examiner	Art Unit	
	Ismael Negron	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18, 19, 21-27 and 33-36 is/are rejected.
- 7) ☒ Claim(s) 17, 20 and 28-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 and 5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It was not executed in accordance with either 37 CFR 1.66 or 1.68.

The oath or declaration is missing the signature of one of the inventors.

Title

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: **Foldable Light Diffusion Box with Frame Assembly.**

Abstract

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should

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include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

3. The abstract of the disclosure is objected to because it fails to positively disclose that which is new in the art to which the claimed invention pertains. Correction is required. See MPEP § 608.01(b).

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “46” has been used to designate both “*opaque panel*” (page 13, line 19) and “*right side panel*” (page 13, line 21). A proposed drawing

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correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Also, note the following:

- reference character "48", used to designate "*panel*" (page 13, line 21) and "*left side panel*" (page 13, line 22);
- reference character "16", used to designate "*diffusion screen or frame*" (page 13, line 9), "*diffusion element*" (page 13, line 22) and "*forwardmost element*" (page 14, line 1);
- reference character "18", used to designate "*diffusion screen or frame*" (page 13, line 9) and "*diffusion element*" (page 13, line 22);
- reference character "62", used to designate "*panel*" (page 14, line 3) and "*smaller panel*" (page 14, line 4);
- reference character "14", used to designate "*holder or bar*" (page 13, line 5) and "*cross-member*" (page 14, line 10);
- reference character "52", used to designate "*frame member*" (page 14, line 3) and "*bottom frame member*" (page 14, line 16);
- reference character "38", used to designate "*frame member*" (page 13, line 18) and "*right side frame member*" (page 14, line 16);
- reference character "60", used to designate "*panel*" (page 14, line 3) and "*large panel*" (page 15, line 4);

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- reference character "80", used to designate "*hinges*" (page 15, line 4) and "*key lights*" (page 18, line 2); and
- reference character "82", used to designate "*angled member*" (page 15, line 6), "*angled bracket*" (page 16, line 6) and "*fill lights*" (page 18, line 2).

The applicant is advised that the reference characters must be properly applied, with no single reference character being used for two different parts or for a given part and a modification of such part. See MPEP §608.01(g).

Applicant is further advised that this action only exemplifies the objections to the drawings, applicant's cooperation is requested in correcting all the occurrences of the cited, or any other errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 22 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation "*means for connecting*" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 24 recites the limitation "*means for connecting*" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

Non-Statutory Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Pat. No. 6,106,125 (hereinafter referred to as Finn et al).

Claims 1-3 of Finn et al. each discloses all the limitations of the claim except the housing having a framed structure for supporting the diffusion element and the light elements.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use framed structure as the main structural element of the housing, to obtain a light, yet structurally strong member that could be quickly assembled or modified to suit the particulars of each application.

7. Claims 2 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Finn et al. in view of Gossner (U.S. Pat. 3,311,745).

Claim 1 of Finn et al. discloses all the limitations of the claim except the housing having a top extending to the front of the housing further than a bottom of the housing.

Gossner discloses a lighting device having a housing with a top surface extending to the front of the housing further than a bottom surface.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the housing geometry of Gossner in the lighting box of Cano, to produce a wide beam of equal intensity that could be projected outwardly and downwardly, as per the teachings of Gossner in column 3, lines 38-40.

8. Claim 4 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Finn et al.. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 1 of Finn et al. discloses all the limitations of the claims, except the light box having an additional diffusion element proximate the front of the housing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an additional diffusion element in the light box of Finn et al., since it has been held that a mere duplication of the essential working parts of an apparatus involves only ordinary skill in the art. *St. Regis Paper Co. v Bemis Co.*, 193 USPQ 8. In this case, once the utility of having one diffusion element is ascertained, including more than one diffusion elements (as suggested by claim one of Finn et al.) to improve the utility of the light box, flows from the readily knowledge available to one of ordinary skill in the art at the time the invention was made.

9. Claims 6, 7, 19, 21, 23 and 25-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of Finn et al.

Claims 1-3 of Finn et al. each discloses all the limitations of the claim except the housing having a framed structure for supporting the diffusion element and the light elements.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use framed structure as the main structural element of the

housing, to obtain a light, yet structurally strong member that could be quickly assembled or modified to suit the particulars of each application.

10. Claims 5 and 8 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of Finn et al.

Claim 2 of Finn et al. each discloses all the limitations of the claim except the housing having a framed structure for supporting the diffusion element and the light elements.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use framed structure as the main structural element of the housing, to obtain a light, yet structurally strong member that could be quickly assembled or modified to suit the particulars of each application.

11. Claims 18, 19, 21 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Finn et al.

Claims 1-3 of Finn et al. each discloses all the limitations of the claim except the housing having a framed structure for supporting the diffusion element and the light elements.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use framed structure as the main structural element of the housing, to obtain a light, yet structurally strong member that could be quickly assembled or modified to suit the particulars of each application.

12. Claims 35 and 36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Pat. No. 6,106,125 (hereinafter referred to as Finn et al).

Claims 1-3 of Finn et al. discloses all the limitations of the claim except the housing having a yoke rotatably connected to the housing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a yoke rotatably connected to the housing to enable the housing to be rotated and aimed at a particular spot, since the examiner takes Official Notice that such rotatable structures are old and well known in the illumination art.

Provisional

13. Claims 1, 16 and 25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of copending Application No. 09/642,315. Although the conflicting claims are not identical, they are not patentably distinct from each.

Claims 1 and 7 of Application No. 09/642,315 teaches all the limitations of the claims, except the housing having a framed structure for supporting the diffusion element and the light elements.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use framed structure as the main structural element of the

housing, to obtain a light, yet structurally strong member that could be quickly assembled or modified to suit the particulars of each application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 2-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7, as applied to claim 1 in Section 13 above, and claims 2-4 and 9-14 of copending Application No. 09/642,315. Although the conflicting claims are not identical, they are not patentably distinct from each.

Claim 2 of the instant application teach limitations which are coextensive with the limitations of claim 2 of Application No. 09/642,315.

Claim 3 of the instant application teach limitations which are coextensive with the limitations of claim 3 of Application No. 09/642,315.

Claim 4 of the instant application teach limitations which are coextensive with the limitations of claim 4 of Application No. 09/642,315.

Claim 5 of the instant application teach limitations which are coextensive with the limitations of claim 11 of Application No. 09/642,315.

Claim 6 of the instant application teach limitations which are coextensive with the limitations of claim 9 of Application No. 09/642,315.

Claim 7 of the instant application teach limitations which are coextensive with the limitations of claim 10 of Application No. 09/642,315.

Claim 8 of the instant application teach limitations which are coextensive with the limitations of claim 11 of Application No. 09/642,315.

Claim 9 of the instant application teach limitations which are coextensive with the limitations of claim 12 of Application No. 09/642,315.

Claim 10 of the instant application teach limitations which are coextensive with the limitations of claim 13 of Application No. 09/642,315.

Claim 11 of the instant application teach limitations which are coextensive with the limitations of claim 14 of Application No. 09/642,315.

This is a **provisional** obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claim 12 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7, as applied to claim 1 in Section 13 above, and claim 11 of copending Application No. 09/642,315. Although the conflicting claims are not identical, they are not patentably distinct from each.

Claim 12 of the instant application recites means for releasably attaching the diffusion element, while claim 11 of the copending Application No. 09/642,315 recites means for removing and replacing the diffusion filter. One of ordinary skill in the art at the time the invention was made would have recognized that the structure claimed in the copending application inherently includes the means for removable attachment claimed in the instant application.

This is a **provisional** obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 13, 33 and 34 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7, as applied to claim 1 in Section 13 above, and claim 6 of copending Application No. 09/642,315. Although the conflicting claims are not identical, they are not patentably distinct from each.

Claim 13 of the instant application recites means for hanging the claimed invention, while claim 11 of the copending Application No. 09/642,315 recites means for hanging the claimed invention in the air. One of ordinary skill in the art at the time the invention was made would have recognized that the structure claimed in the copending application inherently includes the means for hanging claimed in the instant application.

This is a **provisional** obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

17. Claims 17, 20 and 28-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office Action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

19. The following is a statement of reasons for the indication of allowable subject matter:

Applicant teaches a light box for illuminating a stage, such light box having a housing, a light-mounting element, a light diffusion element attached to the housing, and a plurality of lights. The housing is made having a collapsible rigid frame, covered by panels.

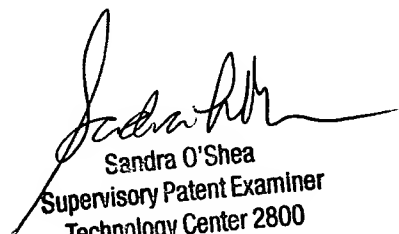
No prior art was found teaching individually, or suggesting in combination, all of the features of the applicants' invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (703) 308-6086. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (703) 305-4939. The facsimile machine number for the Art Group is (703) 308-7382.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800

Inr

June 9, 2002